REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

Claims 2-5 and 7-24 remain pending in the present application. Claims 5 and 11 have been amended to add three new limitations.

The examiner is thanked for the indication of allowability for claims 15, 22, and 24.

The rejection as it applies to the non-allowed claims is traversed insofar as it applies to the claims as now amended. Independent claims 5 and 11 have both been amended to add a limitation requiring the steps of receiving a document via either email or fax and creating a hardcopy of the received document, as well as the limitation of "without adding any address information, scanning the document" to obtain at least one communication address. Also, the claims have been amended to added a "decoding" step. Finally, various inconsistencies created by these new limitations have been corrected in the claims. In this regard, in claim 5, since two addresses are set forth in the last paragraph, the "obtaining" step has been amended to be consistent therewith. In claim 11, since the last paragraph clarifies that the address is obtained from a storage address, the words "directly or" have been deleted to obtain consistency.

Referring to these amendments, the art does not show receiving a document with a communication mark already preexisting on it, creating a hardcopy of that document (such as by printing the document), and then scanning the hardcopy document to obtain a pre-existing communication mark already embodied therein, decoding the mark, and inputting the mark into an address function. This is particularly not the case where the mark itself is a reference and requires access to a URL address or other database location, as in claim 11.

More specifically, Merchant does not receive a document from a fax or email, make a hardcopy of the document, and then without adding any other mark to the document, decode the mark to obtain an address and then input the document to an address function and initiate a communication.

Rather, Merchant et al. teaches handwriting an address into a first format region 50, 52 of a source document, (see column 3, lines 58-63), and scanning the document, which is then sent to a selective call receiver. Likewise, Bloomfield discloses starting with a document already in electronic form, as fax data, and with a desired email address already in the "To" field. See column 8, lines 46-62, column 17, lines 57-61; column 18, lines 41-48. No mark is scanned from a hardcopy document.

The present claimed invention is directed to the problem of taking a hardcopy document, typically a fax or a printed copy of an email, and _automatically_ determining an address directly or indirectly by decoding a communications mark pre-existing on the hardcopy and then going to an address function.

The examiner has not made out a prima facie case of obviousness as required by the office. The examiner admits that Merchant does not teach inputting the communication address into an address function or initiating a communication and cites Bloomfield to make up the deficiency. But there is no motivation set forth in the references that would instigate one of ordinary skill to combine Merchant et al., which is directed to sending faxes to a pager receiver, with Bloomfield, which is directed at sending a fax to an email device. The examiner only cites argument and no teaching in the references themselves for such motivation. In addition to there being no motivation, it is not taught how one of ordinary skill would take these two disparate independent teachings to form an operable system that meets the multiple limitations in applicants' claims.
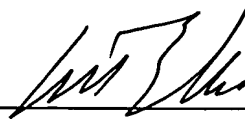
Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date <u>August 15, 2002</u>

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MARKED UP VERSION SHOWING CHANGES MADE

Below are the marked up amended claims:

5.   (Twice Amended)   A method for providing automatic communication addressing comprising the steps of:

receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document;

without adding any address information, scanning the document to obtain at least one[locating a] communication mark, if one is present, on the hardcopy[a medium containing information];

decoding the communication mark to obtain [obtaining] at least [one] a first communication address for a first communication mode and a second communication address for a second different type of communication mode directly or indirectly from said communication mark;

inputting said communication address into an address function of a communication device; and

initiating a communication of said information to said communication address through said communication device;

[wherein said communication mark includes a first communication address for a first communication mode, and a second communication address for a second different type of communication mode].

11.   (Twice Amended)   A method for providing automatic communication addressing comprising the steps of:

receiving a document from one from the group of a fax and an email communication and creating a hardcopy of the document;

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without adding any address information, scanning the document to obtain at least one [locating a]communication mark, if one is present, on the hardcopy[a medium containing information];

decoding the communication mark to obtain [obtaining] at least one communication address [directly or] indirectly from said communication mark;

inputting said communication address into an address function of a communication device; and

initiating a communication of said information to said communication address through said communication device;

wherein said communication mark is a storage address to a location where a communication address is stored.